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REMARKS

The nonfinal Office Action (Paper No. 8) mailed December 2, 2003, and the references of record have been received and reviewed. Claims 12-34 are cancelled without prejudice or disclaimer as being drawn to a nonelected group. Applicants specifically reserve the right to pursue the patent protection provided by these cancelled claims in a divisional application. Claims 1 and 5 are amended, without prejudice or disclaimer, to clarify the claimed method. Claims 35-37 have been added. Accordingly, claims 1-11 and 35-37 are now pending before the Examiner, with claims 4, 7, and 10 temporarily being withdrawn pending allowance of a generic or linking claim. Reconsideration is respectfully requested.

Telephonic interview:

The applicants thank the Examiner for the courtesy of the telephonic interview conducted March 24, 2004. Applicants found the interview very beneficial in more fully understanding the rejections. The present amendments incorporate the amendments discussed therein, which overcome the rejections. The present amendment of the claims presumes entry of the amendment mailed February 24, 2004.

Support for newly added claims 35-37:

Support for claims 35-37 can be found throughout the specification, for example, at page 4, line 22 to page 5, line 2 and FIGs. 14-17.

Further, the method defined in base claim 35 differentiates over the references of record by requiring, for example, the steps of: "manipulating an inflatable member to grasp tissue on the interior of a stretch of said lumen; folding said tubular anatomical structure inwardly upon itself to form an inverted tissue bundle comprising tissue from around a circumference of said lumen, said tissue bundle being disposed within said stretch of said lumen; and applying a ligating structure to said tissue bundle effective to block a passage through said lumen." Applicants submit that none of the references, either alone or taken in combination, teach or suggest forming a tissue bundle inside a tubular anatomical structure with the method as claimed.

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Rejection under 35 U.S.C. §102(a and/or e):

Claim 1 stands rejected under 35 U.S.C. §102(a and/or e) as assertedly being anticipated by Frazier, et al. (US 6,231,561). Applicants respectfully traverse the rejection and clarify the claim by the amendments submitted in this paper. Applicants do not believe that Frazier et al discloses formation of an inverted tissue bundle within the ambit of as-filed claim 1. However, claim 1 now recites in part "grasping tissue with an inflatable member on the interior of said tubular anatomical structure at one or more locations disposed along a lumen of said tubular anatomical structure and manipulating said tubular anatomical structure to form an inverted folded tissue bundle comprising tissue from around the circumference of said tubular anatomical structure" At most, in FIG. 11, Frazier et al. illustrates closing of an aperture. No tissue bundle, and in particular no inverted folded tissue bundle, is evident. Reconsideration and withdrawal of the rejection is thus respectfully requested.

Claims 1, 3, 5 and 6 stand rejected under 35 U.S.C. §102(b) as assertedly being anticipated by Ehlers (US 5,224,497). Applicants respectfully traverse the rejection in view of the clarifying changes made to base claims 1 and 5. Claim 1 now explicitly requires grasping of tissue with an inflatable member at a location along a lumen of the tubular structure and forming an inverted folded tissue bundle. In contrast, Ehlers discloses grasping a tubular structure at an end wall of a dead-end pocket and does not teach or suggest an inflatable member for grasping the tissue. Applicants submit that the gripping structure, an inflatable member, is a different grasping mechanism and that such a mechanism results in a different manipulation of the tubular structure to form an inverted folded tissue bundle than contemplated by Ehlers, and differentiates the method encompassed by base claim 1, and its depending claim 3, from anything either disclosed or adduceable from Ehlers.

Base claim 5 is amended to recite "grasping tissue from the wall of said tubular anatomical structure with said grasper at one or more locations around a circumference of, and disposed apart from an end of, said lumen, wherein said grasper comprises an inflatable end portion." Similarly to claim 1, claim 5 differentiates over any method disclosed by Ehlers for grabbing and manipulating a tubular structure. Claim 6, which depends from base claim 5, is

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similarly differentiated from this reference. Reconsideration and withdrawal of the rejection is respectfully requested.

Rejections under 35 U.S.C. §103(a):

Claim 8 stands rejected under 35 U.S.C. §103(a) as assertedly being unpatentable over Ehlers '497 in view of Booth et al. (US 5,653,690). Applicants respectfully traverse the rejection and submit that there has been no proper *prima facie* showing that the invention defined by this claim, even as-filed, would have been obvious to one of ordinary skill in the relevant art at the time the invention was made. The rejection erroneously construes Booth et al. as disclosing a gripping structure capable of retracting the wall of a tubular structure until that wall is capable of fitting into the first end of an elongated tubular element. At Col. 8, lines 16-24, Booth et al. discloses that friction can be enhanced by gripping a structure to hold their device in place, but does not disclose or suggest any retraction capability enabled by any of their illustrated friction enhancing protrusions. Applicants submit that retraction of at least a portion of a wall of the tubular element is required to form an inverted tissue bundle. Furthermore, the principal reference does not disclose the elements of independent claim 5, from which claim 8 depends, as noted in connection with the 35 USC 102(b) rejection. Booth et al. simply does not supply the missing teachings concerning grabbing and manipulating a tubular structure to form a tissue bundle. Reconsideration and withdrawal of the rejection is thus respectfully requested.

Claim 9 stands rejected under 35 U.S.C. §103(a) as assertedly being unpatentable over Ehlers '497 in view of Booth et al. '690 and further in view of Behl et al. (US 5,709,224). As argued with respect to claim 8, Ehlers modified by Booth et al. do not disclose or suggest all of the elements of claim 5, from which claim 9 indirectly depends. Further, Behl et al. does not supply the missing teachings concerning grabbing and manipulating a tubular structure to form an inverted tissue bundle with an inflatable grasping member. Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 2 and 11 stand rejected under 35 U.S.C. §103(a) as assertedly being unpatentable over Ehlers '497. Ehlers does not teach or suggest all of the elements of claims 1 and 5, as indicated in connection with the 35 USC 102(b) rejection. Thus, Ehlers '497 does not disclose all

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of the claim elements and, therefore, cannot render the claims obvious. Reconsideration and withdrawal of the rejection is respectfully requested.

Double patenting rejection:

Notice of the provisional rejection of the pending claims under the judicially created doctrine of double patenting is acknowledged. Applicants offer to submit the appropriate response to the rejection upon allowance of claims in the later of the two applications.

CONCLUSION

In view of the foregoing amendment and remarks, reconsideration, joinder of claims 4, 7, and 10, and the prompt allowance of claims 1-11, and 35-37 are respectfully solicited. Should any issues remain unresolved subsequent to the receipt of this paper, the Examiner is invited to contact the undersigned representative to resolve the matter.

Respectfully submitted,



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